

### **REMARKS**

Claims 1-5 and 12-21, as amended, and new claims 22-25 are pending in this application. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claims 1 and 17 have been amended in a manner discussed with the Examiner in order to clarify the invention. Claim 16 has also been rewritten in a manner to avoid antecedent basis issues. Moreover, claims 6-11 have been canceled. Finally, claims 22-25 have been added to recite an additional embodiment of the invention incorporating the features of claims 1 and 17, which is subject matter that is fully supported by the grandparent application no. 09/721,749, filed November 27, 2000.

As no new matter has been added, Applicants respectfully request entry of these amendments at this time.

### **THE INTERVIEW**

Applicants appreciate the courtesies extended by the Examiner during the interview held on July 19, 2005. The claim amendments and arguments herein are substantially in accord with the discussion during the interview. In addition, Applicants submit an Information Disclosure Statement to formally disclose the existence of litigation regarding the parent patent (6,818,705). As discussed during the interview, included in the opposing counsel's allegations regarding the '705 patent is an invalidity argument based on references considered by the Examiner both in the '705 patent and the present application.

### **THE REJECTION UNDER 35 U.S.C. § 112**

Claim 16 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons provided on page 2 of the Office Action. This claim has been rewritten in a manner to avoid any antecedent basis issues. As such, Applicants respectfully request reconsideration and withdrawal of the § 112 rejection.

## **THE REJECTIONS UNDER 35 U.S.C. §§ 102 & 103**

### ***No Combination of Moriyama '396 and Higuchi Does Not Anticipate or Render Obvious the Present Invention***

Claims 1-6 and 8 were rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under §103(a) as obvious over U.S. Patent No. 5,980,396 to Moriyama *et al.* for the reasons set forth on page 3 of the Office Action. In addition, claims 12-14 and 16 were rejected under § 103(a) as obvious over Moriyama '396 in view of U.S. Patent No. 6,142,888 to Higuchi *et al.* as provided on page 3 of the Office Action. Moriyama '396 alone, or in combination with Higuchi, does not disclose or suggest the present invention for the reasons that follow.

The objective of Moriyama '396 is to provide long flight distance and good shot feel. Col. 1, lines 35-37. To achieve this objective, Moriyama '396 proposes a four-piece golf ball with a vulcanized rubber center, a thermoplastic or vulcanized outer core layer, a vulcanized rubber or thermoplastic intermediate layer, and a thermoplastic outer cover layer. *See, e.g.*, Col. 2, lines 10-19 and 30-54. This selection of materials is arranged to provide a soft-hard-soft-hard from the center to the cover. Col. 2, lines 15-19.

Moriyama '396 is silent, however, as to an organosulfur compound as a cis-to-trans catalyst. In fact, while the examples in the Moriyama '396 patent do include diphenyl disulfide (*see* Table 1), Moriyama '396 is completely silent as to the purpose of this component, *i.e.*, there is no teaching regarding cis-to-trans conversion based on the use of diphenyl disulfide. Based on this lack of instruction, one of ordinary skill in the art would not have been motivated to modify the composition to include anything other than diphenyl disulfide absent the use of impermissible hindsight. For at least this reason, Applicants respectfully submit that Moriyama '396 does not anticipate or render obvious the invention presently recited in claims 1-6 and 8.<sup>1</sup>

With regard to claims 12-14 and 16, because Moriyama '396 does not disclose specific teaching regarding a polyurethane outer cover layer, the Examiner relies on Higuchi for its disclosure regarding polyurethane. Higuchi, however, does not cure the deficiencies of Moriyama '396 with respect to the type of cis-to-trans catalyst now recited in independent claim 1. In fact, Higuchi, like Moriyama '396, is completely silent as to cis-to-trans conversion in the core and, as such, does not disclose or even suggest cis-to-trans catalysts. Thus, Applicants respectfully submit

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<sup>1</sup> It appears that the Examiner also recognizes the deficiencies of the cited reference with respect to a metal organosulfur compound in light of the absence of §§ 102 and 103 rejections of claim 7, as previously recited.

that the combination of Moriyama '396 and Higuchi does not result in the present invention, nor does it render obvious the present invention.

For the reasons discussed above, Moriyama '396 alone, or in combination with Higuchi, does not disclose or suggest the invention presently recited in independent claim 1, and those claims depending therefrom. Thus, Applicants respectfully request reconsideration and withdrawal of the §§ 102 and 103 rejections based on the cited references.

*No Combination of Sullivan, Moriyama '856, or Peter Render Obvious the Present Invention*

The Examiner also rejected claims 1-6, 8, 12-13, and 16-21 under § 103(a) as obvious over U.S. Patent No. 6,210,293 to Sullivan in view of U.S. Patent No. 5,697,856 to Moriyama *et al.* for the reasons stated on pages 3-4 of the Office Action. In addition, claims 12-21 were rejected under § 103(a) as obvious over Sullivan in view of Moriyama '856 and U.S. Patent No. 6,309,313 to Peter as provided on page 4 of the Office Action. Sullivan alone or in any combination with Moriyama '856 or Peter does not disclose or suggest the present invention.

As recognized by the Examiner, Sullivan does not disclose or suggest cis-to-catalysts in the core composition. Because of this silence, the Examiner has relied upon Moriyama '856 for its disclosure of catalyst. However, Moriyama '856 teaches that the trans structure after vulcanization *must* be within the range of 10 percent to 30 percent. Col. 3, lines 27-29 (emphasis added). In fact, the reference *teaches away* from the claimed amount of trans-polybutadiene isomer in stating that “when the amount of trans structure exceeds 30 percent, the core is too soft and the resilience performances are deteriorated.” Col. 3, lines 31-33. In contrast, independent claim 17 now recites a reaction product having a trans-polybutadiene isomer content of greater than about 32 percent. Thus, one of ordinary skill in the art would have lacked any motivation to make a core with the recited trans-isomer content without the present invention to use as a template. As such, the combination of Sullivan and Moriyama '856 does not render obvious the invention presently recited in claim 17 and those claims depending therefrom.

With regard to claim 1 and those claims depending therefrom, like Moriyama '396, Moriyama '856 does not disclose or suggest a metal organosulfur compound. Instead, Moriyama '396 discloses sulfides. As such, the combination of Sullivan and Moriyama '856 also does not render obvious the invention recited in independent claim 1.

The combination of Sullivan, Moriyama '856, and Peter also does not form the basis of a prima facie case of obviousness. For example, as discussed above, Sullivan and Moriyama '856 both have deficiencies with regard to the present invention recited in independent claims 1 and 17. Peter does not cure these deficiencies. In fact, the Examiner cited Peter merely for its disclosure of polyurethane covers. Peter is completely silent, however, as to the formulation of the core disposed beneath the polyurethane covers.

For the reasons set forth above, Applicants respectfully submit that no combination of Sullivan, Moriyama '856, or Peter discloses or suggests the present invention. Consequently, Applicants respectfully request reconsideration and withdrawal of the rejections based thereon.

### **THE DOUBLE PATENTING REJECTION**

The Examiner rejected claims 1-21 under the judicially created doctrine of obviousness-type double patenting as obvious over claims 1-50 of the grandparent patent no. 6,486,261 to Wu *et al.* and claims 1-22 of parent patent no. 6,818,705 to Wu *et al.* In addition, claims 1-21 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting based on co-pending U.S. Patent Application Nos. 10/694,746, 10/694,800, 10/694,798, and 10/694,801. Applicants submit herewith a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) in order to overcome the double patenting rejections based on the parent and grandparent patents and co-pending patent applications. As such, Applicants respectfully request that the double patenting rejection be withdrawn.

### **CHANGE IN ATTORNEY DOCKET NUMBER**

A Request for Change in Attorney Docket Number is submitted herewith to change the docket number from 20002.0263A to 20002.0363.

### **CONCLUSION**

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response one month to and including August 15, 2005. A Fee Sheet Transmittal is submitted to pay for this extension, the Terminal Disclaimer, and the Information Disclosure Statement. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Swidler Berlin LLP Deposit Account No. 195127, Order No. 20002.0363.

Respectfully submitted,  
SWIDLER BERLIN LLP

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